

**U.S. Pat. Appl. Ser. No. 10/588,181
Attorney Docket No. 10191/4255
Reply to Office Action of August 31, 2010**

REMARKS

Claims 13 to 24 are pending in the present application.

The Examiner requires restriction to one of the following inventions:

Species I: directed to the embodiment(s) of figures 2-6; and

Species II: directed to the embodiment(s) of figure 7.

While Applicants do not agree with the merits of this restriction requirement for the reasons explained below, *Applicants elect with traverse Species I, corresponding to claims 13-16 and 19-24.*

Applicants traverse the requirement of restriction for the following reasons.

Unity of Invention

The present application is a national stage entry application of an International Patent Application, under 35 U.S.C. § 371. As stated in M.P.E.P. § 1896, restriction practice for such an application differs from one filed under 35 U.S.C. § 111, in that the former is subject to unity of invention practice under 37 C.F.R. § 1.499 while the latter is subject to U.S. restriction practice under 37 C.F.R. §§ 1.141 - 1.146. Thus, the present application is subject to unity of invention practice.

Under a proper analysis, performed under unity of invention practice, the Office Action fails to establish that the claims are not “so linked as to form a single general inventive concept.” PCT Rule 13.1.

In this regard, the Office Action **fails to establish lack of unity of invention** since the Office Action has not identified any prior art considered with respect to any of the claims, has not indicated which features of the claims distinguish the claims over the prior art, and has not indicated whether a determination has been made that the claims of Species I and II do not share any special technical feature that distinguishes the claims over the prior art.

In this regard, it is noted that unlike U.S. restriction practice, whether each of different claims includes technical features that the others of the claims do not have is irrelevant in a lack of unity analysis, except to the extent it is determined that the different claims do not share any of the same technical features. In order to make this determination with respect to two claims ‘A’ and ‘B,’ it must be determined that none of the features which

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distinguish claim ‘A’ over the prior art are included in claim ‘B’ and also that none of the features which distinguish claim ‘B’ over the prior art are included in claim ‘A.’

“A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature.” M.P.E.P. § 1893.03(d) (emphasis added). That is, as long as at least one common special technical feature is shared among all of the claims, the claims must be considered as being directed to a single general inventive concept.

Therefore, a determination of lack of unity cannot be made without first considering the relevant prior art, except where there is no subject matter which is common to all of the claims. Where there is any subject matter which is common to all of the claims, **unity of invention is necessarily present**, unless it is determined that the common subject matter does not distinguish the claims over the prior art. As explained in M.P.E.P. § 1850(II), only the case of “independent claims to A + X, A + Y, X + Y can be said to lack unity *a priori* [i.e., prior to considering the prior art,] as there is no subject matter common to all of the claims [since A is lacking in claim 3, X is lacking in claim 2, and Y is lacking in claim 1. However, in] the case of independent claims to A + X and A + Y, unity of invention is present *a priori* as A is common to both claims.” (Emphasis added.)

Moreover, “[u]nity of invention has to be considered in the first place only in relation to the independent claims . . . and not the dependent claims . . . If the independent claims avoid the prior art . . . , no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention.” *Id.* (emphasis added).

Application of the Rules to the Present Claims

In the present application, the requirement for restriction between Species I and II is improper. All of claims 14-24 depend from a single independent claim 13 so that unity of invention is therefore necessarily present *a priori*, i.e., prior to consideration of any of the relevant prior art. Specifically, all of claims 13-24 share at least the technical features of independent claim 13, so that all of the claims share at least one “same or corresponding special technical feature.” The Office Action has not identified any prior art that has been considered with respect to the claims. Specifically, the Office Action has not identified any prior art that renders the independent claim 13 not novel and obvious.

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Unity of invention is therefore necessarily present between all of claims 13-24, since whichever feature might distinguish independent claim 13 over the prior art is present in all of the presently pending claims. Since that feature is present in each of claims 13-24, therefore all of claims 13-24 are so linked as to form a single general inventive concept under PCT Rule 13.1. **Therefore, with election of claim 13, no restriction between the dependent claims 14-24 can be made based on a lack of unity of invention.**

That is, at least one common technical feature is shared by all of the present claims, since all of the technical features of claim 13 are included in all of its dependent claims. Therefore, that Species I and II might differ in that they may include different additional features that pertain to different ones of the described embodiments is irrelevant. **Therefore, no restriction requirement of species can be made between any of claims 13-24.**

Stated simply, whether one claim includes features not included in another claim is irrelevant. The only relevant question is whether all of the claims share at least one technical feature. Since all of the present claims do share at least one common technical feature, therefore there is unity of invention.

The Office Action therefore fails to establish lack of unity of invention.

Applicants respectfully request an early and favorable action on the merits.

Respectfully submitted,

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